



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

: **Confirmation No. 8571**

Franz SIEBERER

: Attorney Docket No. 2004_0129A

Serial No.10/773,275

: Group Art Unit 3679

Filed February 9, 2004

: Examiner Ernesto Garcia

TRANSPORT SECURING ARRANGEMENT : **Mail Stop: APPEAL BRIEF-PATENTS**

APPEAL BRIEF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

The following is Appellant's Brief, submitted under the provisions of 37 CFR 41.37.

Pursuant to the provisions of 37 CFR 41.20, this Brief is submitted with a fee of \$500.00.

Further, the Brief is accompanied by a Petition and fee for a one month extension of time period set forth in 37 CFR 41.37(a)(1).

05/12/2006 JADD01 00000028 10773275

02 FC:1402

500.00 0P

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEES FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975

REAL PARTY IN INTEREST

The real party in interest is Palfinger AG, the assignee of record.

RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

STATUS OF CLAIMS

Claims 1-7 and 9 stand finally rejected.

Claim 8 has been objected to as being dependent upon a rejected base claim, but the Examiner has indicated that this claim would be allowable if rewritten in independent form (see Advisory Action dated January 10, 2006).

The rejections of claims 1-7 and 9 are being appealed. A complete copy of all the claims on appeal is provided in the attached Claims Appendix.

STATUS OF AMENDMENTS

An amendment filed December 23, 2005 subsequent to the final Office Action of August 23, 2005, in which changes were made to the drawings, has been entered. Appellant acknowledges the objections to the drawings set forth by the Examiner in the Advisory Action, and notes that such objections will be addressed after the present appeal is resolved.

SUMMARY OF CLAIMED SUBJECT MATTER

A description of the subject matter of the rejected claims is presented below with reference to the written description and drawings of this application. In this regard, it is noted that all references to the specification refer to the substitute specification filed on May 27, 2005.

The subject matter of the present invention is directed to a transport securing arrangement for a side extension arm 15 of a vehicle 14 (see page 3, lines 22-23; and Fig. 1a). The transport securing arrangement includes a locking device 1 and a securing hook 10 that are arranged such that both of the locking device 1 and the securing hook 10 are operable to act on the side extension arm 15 (see page 4, lines 17-20), and such that a release of the locking device 1 leads to a release of the securing hook 10 from an anchorage position (see page 5, lines 11-14; Figs. 2a-2c; and Figs. 4a-4c).

For example, when the extension arm 15 is in a secured and locked transport position, as shown in Figs. 2b and 2c, the securing hook 10 is urged by a spring 3 in the direction of its anchorage position, whereby the securing hook 10 surrounds a pin portion 4 of the side extension arm 15 so as to anchor the securing hook 10 (see page 4, lines 14-16; and page 4 line 21 through page 5, line 1). In addition, as shown in Fig. 2b, a pin 6 of the locking device 1 is urged by a spring 12 into a locking opening 13 of the side extension arm 15 so as to anchor the locking device 1 (see page 4, lines 16-17).

When it is desired that the extension arm 15 be released from the secured and locked transport position, the locking device 1 is rotated by a handle 9, which causes the pin 6 to be moved out of the locking opening 13 of the side extension arm 15, and also causes the securing hook 10 to be pivoted away from the pin portion 4 of the side extension arm 15 (see page 5, lines 11-14; Figs. 2a-2c; and Figs. 4a-4c).

Thus, as described on page 4, lines 17-20, unintentional movement of the side extension arm 15 out of its secured and locked transport position is prevented by the securing hook 10 which embraces the pin portion 4 of the side extension arm 15 and also, independently thereof, by the insertion of the pin 6 of the locking device 1 into the anchorage opening 13 of the side extension arm 15 (see Figs. 2b and 2c). Accordingly, as explained on page 7, line 23 through page 8, line 5, by providing a locking device 1 that is able to lock the side extension arm 15 in place, as well as a securing hook 10 that is also able to lock the side extension arm 15 in place, the side extension arm 15 is doubly secured in its transport position.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-6 and 9 are unpatentable under 35 U.S.C. § 102(b) over EP 0 694 460.
2. Whether claims 1, 4 and 7 are unpatentable under 35 U.S.C. § 102(b) over U.S. 4,943,181 to Murphy.

ARGUMENT

An invention is anticipated if the same device, including all of the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally

present, arranged as in the claim. Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984). As will be explained in detail below, neither the EP 0 694 460 reference nor the U.S. 4,943,181 reference meets this requirement.

I. Rejection of claims 1-6 and 9 under 35 U.S.C. § 102(b) as being anticipated by EP 0 694 460 (hereinafter “the ‘460 reference”)

A. Claims 1-5 and 9

Claim 1 is drawn to a transport securing arrangement for a side extension arm of a vehicle, the transport securing arrangement including a locking device and a securing hook, wherein the locking device and the securing hook are arranged such that both the locking device and the securing hook are operable to act on the side extension arm. Appellant submits that the ‘460 reference does not disclose such a feature.

Initially, Appellant notes that in the Final Office Action, the Examiner took the position that the above-noted feature is a “mere abstract idea” to which no structure can be associated (see Final Office Action at page 7). Appellant disagrees. In particular, Appellant submits that the above-noted feature is not a mere abstract idea, but instead, is a functional limitation of the claim which defines the structural arrangement of the claimed apparatus. In other words, according to claim 1, the locking device and securing hook must be arranged as part of the claimed apparatus such that they are operable to act on the side extension arm.

Appellant notes that the MPEP specifically points out that there is nothing intrinsically wrong in defining something by what it does rather than by what it is. In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. See MPEP §2173.05(g).

Turning to the disclosure of the ‘460 reference, Appellant notes that this reference discloses a horizontal beam 1 which is displaceable in a housing 2 (see Figs. 2a-2c). As shown in Fig. 2c of the ‘460 reference, a rotatable lever 3 is attached to the beam 1, wherein a claw 4 is provided on the lever 3. When the beam 1 is not secured in a closed position (i.e., when the beam 1 is not locked inside the housing 2), the rotatable lever 3 projects over the end of the beam

1, thereby acting as a signal that the beam 1 is not secured in the locked position (see the Abstract; and Figs. 2c and 3c).

As shown in Fig. 3c of the '460 reference, a detent member 11, which is attached to the beam 1, operates so as to fix the lever 3 in the downward position (i.e., the signaling position) by engaging an end portion 10 of the lever 3 (see the Abstract). As shown in Fig. 3b, by moving the beam 1 toward the housing 2, the detent member 11 engages a protrusion 12 on the housing 2, thereby releasing the end portion 10 of the lever 3 from the detent member 11 (see Fig. 3b).

Upon release of the end portion 10 of the lever 3 from the detent member 11, a spring 8 acts so as to pivot the lever 3 upwardly due to the spring 8 (see Figs. 2b and 3b). When the lever 3 is rotated upwardly, the claw 4 on the lever 3 engages a round bar 5 on the housing 2 so as to fix the beam 1 in the housing 2 (see Figs. 2a-2c).

As noted above, claim 1 is drawn to a transport securing arrangement for a side extension arm of a vehicle, wherein a locking device and a securing hook are arranged such that both the locking device and the securing hook are operable to act on the side extension arm.

In the Final Office Action, the Examiner has taken the position that in the '460 reference, the detent member 11 corresponds to a "locking device" and that the end portion 10 of the lever 3 corresponds to a "securing hook" (see Final Office Action at page 4). Further, based on the disclosure in the '460 reference, it is clear that the Examiner is taking the position that the beam 1 corresponds to the "side extension arm of the vehicle".

Thus, based on the above-noted correspondence, the Examiner is alleging that the detent member 11 and the end portion 10 of the lever 3 are arranged such that both the detent member 11 and the end portion 10 of the lever 3 are operable to act on the beam 1. Appellant respectfully disagrees.

In particular, as discussed above, both the detent member 11 and the end portion 10 of the lever lever 3 are attached to the beam 1 (see Fig. 2c and Fig. 3c). Accordingly, as the detent member 11 and the lever 3 are attached to the beam 1, it is clear that the detent member 11 and the end portion 10 of the lever 3 are not operable to act on the beam.

For example, while the detent member 11 can be engaged by the protrusion 12 of the housing 2 when the beam 1 is being moved toward the housing 2, the detent member 11 itself

does not act on the beam 1. Similarly, while the end portion 10 of the lever 3 is used in conjunction with the detent member 11 to secure the lever 3 in the signaling position (i.e., the position show in Fig. 3c), the end portion 10 of the lever 3 also clearly does not act on the beam 1.

In the Advisory Action, it is noted that the Examiner indicates that any argument making reference to a “beam” is irrelevant as a “beam” is not claimed. As noted above, however, the Examiner is clearly taking the position that the beam 1 in the ‘460 reference corresponds to the “side extension arm” as recited in claim 1. Accordingly, the comments making reference to the “beam” are plainly directed to the “side extension arm” as recited in claim 1.

In view of the foregoing, Appellant submits that the ‘460 reference does not disclose, suggest or otherwise render obvious the feature of the locking device and securing hook being arranged such that both the locking device and the securing hook are operable to act on the side extension arm. Accordingly, Appellant submits that claim 1 is patentable over the ‘460 reference.

Claims 2-5 and 9 depend from claim 1 and are therefore considered patentable at least by virtue of their dependency.

B. Claim 6

Claim 6 depends from claim 1 and is therefore considered patentable at least by virtue of its dependency. In addition, Appellant notes that claim 6 recites that the release of the locking device is independent of a direction of rotation of the locking device. Appellant submits that the ‘460 reference fails to disclose or suggest such a feature.

As noted above, the Examiner has taken the position that the detent member 11 of the ‘460 reference corresponds to the “locking device” as claimed. Regarding the detent member 11, Appellant notes that while the detent member 11 is pivoted upon its engagement with the protrusion 12 so as to be released from the end portion 10 of the lever 3, the release of the detent member 11 from the end portion 10 of the lever 3 is clearly not independent of the direction of rotation of the detent member 11 (see Fig. 3b).

That is, as shown in Fig. 3b of the '460 reference, the detent member 11 is clearly only released from the end portion 10 of the lever 3 by pivoting in a single direction. As such, the release of the detent member 11 from the end portion 10 of the lever 3 is clearly not independent of the direction of rotation of the detent member 11.

In the Advisory Action, the Examiner indicates that the locking device in the '460 reference (i.e., the detent member 11) does not "dependently move" the hook (i.e., the end portion 10 of the lever 3) in the same fashion gears move. While it is not fully understood by Appellant what point the Examiner is trying to convey by the above-noted statement, it appears as though the Examiner is taking an unreasonably broad interpretation of the phrase "independent of a direction of rotation of the locking device".

Appellant submits that the phrase "the release of said locking device is independent of a direction of rotation of the locking device" clearly means that the locking device can be released irrespective of the direction of rotation of the locking device (i.e., the locking device can be released by rotation in either a clockwise or counter-clockwise direction). Thus, as the detent member 11 of the '460 reference can only be released from engagement with the end portion 10 of the lever 3 by rotating in one direction (see Fig. 3b), Appellant submits that the '460 reference fails to disclose or suggest the above-noted feature recited in claim 6.

In view of the foregoing, Appellant submits that claim 6 is patentable over the '460 reference, an indication of which is kindly requested.

II. Rejection of claims 1, 4 and 7 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,870,467 to Murphy (hereinafter "Murphy")

Claims 1, 4 and 7

As noted above, claim 1 is drawn to a transport securing arrangement for a side extension arm of a vehicle, wherein a locking device and a securing hook are arranged such that both the locking device and the securing hook are operable to act on the side extension arm. Appellant submits that Murphy does not disclose such a feature.

As mentioned above, the Examiner has taken the position that the above-noted feature is a "mere abstract idea" to which no structure can be associated. For the reasons discussed above

with respect to the rejection of claim 1 based on the '460 reference, Appellant disagrees and submits that the above-noted feature must be considered and evaluated just like any other limitation of a claim for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. See MPEP §2173.05(g).

Regarding the Murphy reference, Appellant notes that this reference discloses a locking quick disconnect device 10 that is used to lock a tooling attachment 14 to a boom 12 (see Fig. 1; col. 2, line 66 through col. 3, line 4; and col. 4, lines 30-33). In Murphy, the locking quick disconnect device 10 includes a cam arrangement 15 and a locking member 13 (see col. 3, lines 5-7). As shown in Figs. 4 and 5, the cam arrangement 15 and the locking member 13 of the locking quick disconnect device 10 can engage and disengage with one another so as to lock and unlock the tooling attachment 14 to/from the boom 12 (see Fig. 1 and col. 4, lines 25-40).

As noted above, claim 1 is drawn to a transport securing arrangement for a side extension arm of a vehicle, wherein a locking device and a securing hook are arranged such that both the locking device and the securing hook are operable to act on the side extension arm.

In the Final Office Action, the Examiner has taken the position that in Murphy, the cam arrangement 15 corresponds to a "locking device" and the locking member 13 corresponds to a "securing hook" (see Final Office Action at page 5). Further, based on the disclosure in Murphy, it is clear that the Examiner is taking the position that the tooling attachment 14 corresponds to the "side extension arm".

Thus, based on the above-noted correspondence, the Examiner is alleging that the cam arrangement 15 and the locking member 13 are arranged such that both the cam arrangement 15 and the locking member 13 are operable to act on the tooling attachment 14. Appellant respectfully disagrees.

In particular, Appellant notes that in Murphy, the locking member 13 forms part of the tooling attachment 14 (i.e., the locking member 13 is rigidly mounted to the tooling attachment 14) (see col. 3, lines 11-13). Thus, upon the disengagement of the locking member 13 and the cam arrangement 15, the tooling attachment 14 having the locking member 13 rigidly mounted thereto, is released from the boom 12. Accordingly, as the locking member 13 forms part of the

tooling attachment 14, it is clear that the locking member 13 is not operable to act on the tooling attachment 14.

In view of the foregoing, Appellant submits that Murphy does not disclose, suggest or otherwise render obvious the feature of the locking device and securing hook being arranged such that both the locking device and the securing hook are operable to act on the side extension arm, as recited in claim 1. Accordingly, Appellant submits that claim 1 is patentable over Murphy.

Claims 4 and 7 depend from claim 1 and are therefore considered patentable at least by virtue of their dependency.

III. Conclusion

For the reasons set forth above, it is respectfully submitted that claims 1-7 and 9 are not anticipated by either the '460 reference or the Murphy reference. Accordingly, the Board is requested to reverse the Examiner's rejections of claims 1-7 and 9.

Respectfully submitted,

Franz SIEBERER

By Kenneth W. Fields
Kenneth W. Fields
Registration No.52,430
Attorney for Appellant

KWF/dib
Washington, D.C.
Telephone (202) 721-8200
Facsimile (202) 721-8250
May 11, 2006

CLAIMS APPENDIX - claims on appeal

1. A transport securing arrangement for a side extension arm of a vehicle, said transport securing arrangement comprising:

a locking device; and

a securing hook,

wherein said locking device and said securing hook are arranged such that both said locking device and said securing hook are operable to act on the side extension arm, and

wherein said locking device is arranged in relation to said securing hook such that a release of said locking device leads to a release of said securing hook from an anchorage position.

2. A transport securing arrangement as set forth in claim 1, wherein said securing hook is pivotably supported.

3. A transport securing arrangement as set forth in claim 1, further comprising a spring, wherein said spring urges said securing hook into the anchorage position.

4. A transport securing arrangement as set forth in claim 1, wherein said locking device is rotatably supported.

5. A transport securing arrangement as set forth in claim 4, wherein said locking device is releasable by rotation of said locking device.

6. A transport securing arrangement as set forth in claim 5,
wherein said locking device is releasable upon rotation of said locking device, and
wherein the release of said locking device is independent of a direction of rotation of said
locking device.

7. A transport securing arrangement as set forth in claim 4, further comprising a pin,
wherein said locking device has at least one guide surface extending in an inclined
manner relative to a longitudinal center line of said locking device, and
wherein upon rotation of said locking device, said at least one guide surface of said
locking device slides along said pin.

9. A transport securing arrangement as set forth in claim 1,
wherein said locking device includes an eccentrically shaped portion, and
wherein said securing hook partially bears against said eccentrically shaped portion of
said locking device.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None